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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,225	02/04/2004	Shilin Chen	SC-03-02	2188

29106 7590 02/07/2007  
GROOVER & HOLMES  
BOX 802889  
DALLAS, TX 75380-2889

EXAMINER
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JONES, HUGH M

ART UNIT	PAPER NUMBER
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2128

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

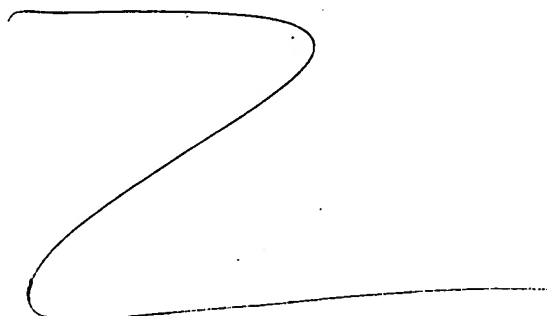
If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**DETAILED ACTION/1.105 REQUIREMENT FOR INFORMATION**

1. Claims 1-104 of U. S. Application 10/772,225, filed on 2/4/2004 are pending. The holding of suspension is withdrawn.
2. This action is in response to Applicant's submissions filed 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004. This action is also in response to Applicant's remarks of 1/8/2007. Applicants are thanked for the information that they have submitted in response to the 1.105 requirement for information. However, the reply is incomplete. The requirement is therefore repeated.

***Response to Arguments***

3. Applicants appear to argue that they do not have to identify documents that are known to be material. Rule 1.56 requires disclosure of "all material known to be material to patentability". The rule *does not* require or *authorize* submission of irrelevant documents or documents which have *not been reviewed*. "Applicant has obligation to call most pertinent prior patent to attention of Patent Office in a proper fashion and to attempt to patentably distinguish his claimed invention from disclosure of patent" 175 USPQ 260. PENN YAN BOATS, INC. v. SEA LARK BOATS, INC., et al.. It is noted that the voluminous submission in the instant application is orders of magnitude greater than in the Penn Yan case.
4. Applicants state:



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Under 37 C.F.R. § 1.105, an examiner may "require individuals to submit information as may be reasonably necessary to properly examine or treat the matter" in a pending application. 37 C.F.R. § 1.105(a)(1); cf. MPEP § 704.10. "There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. [An RFI] places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 C.F.R. § 1.105 may only be made when the examiner has a reasonable basis for requiring information." MPEP § 704.11.

5. Applicant's remarks regarding burden are noted. Applicants are reminded that they have submitted the information disclosure statements *and continue to do so* in copending applications. Applicants are also reminded that the average Examiner has a finite number of *hours* to examine the patent application. This includes the reading the specification and drawings, studying the claims, conducting a prior art search, and making a determination of whether the claims are anticipated or obvious over the prior art of record and communicating the determinations to Applicants. It would be an extreme burden, if not impossible, to additionally carefully consider multiple thousands of pages of dense prior art and legal decisions and to make a careful determination of novelty and non-obviousness with respect to those documents.

6. Applicants' submissions constitute many thousands of pages and include, for example, numerous textbooks. It would be impossible, for example, to read a textbook in the time allotted, let alone the rest of the disclosures. Applicants desire to have the documents carefully reviewed. The Examiner, respectfully, can not in good conscience indicate, by signing the IDS statement that he has considered documents, that the documents has been carefully reviewed. See 37 C.F.R. 1.104(a)(1):



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"[T]he examiner shall make a thorough study [of the application] and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention."

7. The required information is reasonably necessary to properly examine the application.

8. Applicants state:

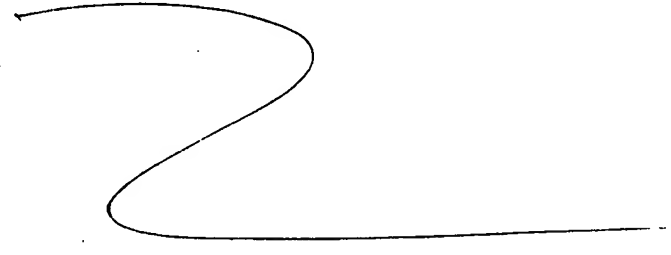
It is well settled that "the terms 'factual' and 'facts' are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought." *MPEP § 704.11*. Thus, requirements under 37 CFR 1.105 may not be used to request opinions that may be held or would be required to be formulated by applicant. *Id.*

9. Applicant's determination and finding of facts that led to the submissions are required, not Applicant's opinion. Applicants are reminded that a reasonable inquiry is required *before* submission of documents.

10. Applicants state:

Where factual information requested is related to the subject application, the "applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested. Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information." *MPEP § 704.11*. Like obligations imposed by the duty of candor and good faith, section 1.105 requires an applicant to submit information already known, "but there is no requirement to search for information that is unknown." *MPEP § 704.12(a)*.

11. Applicants are reminded that a "reasonable inquiry" is required *before* the submission of documents. Applicants are required to submit information already known. The submission of so many documents is not understood if Applicants have not made a reasonable inquiry of the documents.



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12. Applicants have in fact have submitted more IDS statements in copending applications. In one of the IDS statements, a patent issued in 1916, almost a century ago, is listed.

init	Cite.No.	Patent No.	Date	Patentee
	1	1209299	1916-12-19	Hughes
	2	1263802	1918-04-23	Reed
	3	1394769	1921-10-25	Sorensen

13. Applicants are also reminded that an explanation of relevance of non-translated foreign documents is required. Thus, it is possible and reasonable to provide statements of relevance of the other submissions.

14. For these reasons, the requirement for information is again made.

#### 1.105 REQUIREMENT FOR INFORMATION

15. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information (see items A-F) that the examiner has determined is reasonably necessary to the examination of this application:

A. Stipulate whether each and every individually cited reference listed on the IDS(s) submitted 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004 is material to the patentability of the instant application; the applicant may either *agree* or *disagree* for each cited reference.

1. Identify, for each and every citation listed on the IDS(s) submitted 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004, for which applicant *agrees* is material to the patentability:

- a. The differences between the claimed invention and those references cited therein,
- b. How each reference is material to the patentability, based upon the technical and legal knowledge of the Applicant, of the claimed invention,

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- c. Provide how the instant claimed invention is an improvement over each and every reference that is listed in the IDS submission(s) dated 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004.
- B. Provide a copy of any non-patent literature, published applications, or patent (US or Foreign) *used in drafting the instant application, whether or not cited* in the IDS submission(s) dated 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004.
- C. Provide a copy of any non-patent literature, published application, or patent (US or Foreign) that was *used in the inventive process to accomplish the applicant's inventive results*.
- D. At least four provisional applications are listed as providing priority to the instant application. Indicate with specificity where support is provided for each of the claims in all priority applications (provisional and nonprovisional).
- E. Provide the date of first use of the claimed invention, known by any of the inventors or Applicant, at the time the application was filed *notwithstanding* the date of use.
- F. Trademark(s) or Copyright(s) for the product(s) incorporating the instant claimed invention.
- G. In order to constitute a complete response Applicant is required to include stipulations for each and every reference cited in the IDS submission(s) dated 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004 as well as each and every IDS submission thereafter, as delineated in requirement A.

16. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures

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beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

17. Applicants have submitted requests for status in this application and of co-pending applications in which a request for interference has been entered. Applicants are reminded that their assistance with the numerous and voluminous information disclosure statements was repeatedly requested in co-pending applications. Applicants were and continue to be *silent* in response. Applicant's assistance in reducing the burden on the office is gratefully anticipated.

18. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

19. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of two months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

20. **Any inquiry concerning this communication or earlier communications from the examiner should be:**

directed to: Dr. Hugh Jones telephone number (571) 272-3781,

Monday-Thursday 0830 to 0700 ET,

*or*

the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

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**mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**


(703) 308-9051 (for formal communications intended for entry)

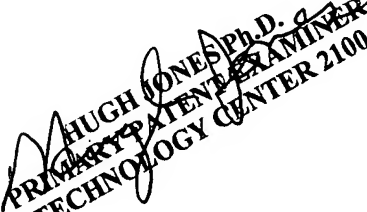
*or* (703) 308-1396 (for informal or draft communications, please label *PROPOSED* or *DRAFT*).

Dr. Hugh Jones

Primary Patent Examiner

January 30, 2007

  
WILLIAM THOMSON  
SUPERVISORY PATENT EXAMINER

  
HUGH JONES Ph.D.  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100